UNITED STATES PATENT AND TRADEMARK OFFICE

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James E. Boice
DILLON & YUDELL LLP
8911 North Capital of Texas Highway
Suite 2110
Austin, TX 78759

EXAMINER
SMITHERS, MATTHEW

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/733,737
Filing Date: December 08, 2000
Appellant(s): ADIANO ET AL.

MAILED

AUG 0 9 2007

Technology Center 2100

James E. Boice
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 March 2006 appealing from the Office

action mailed 26 August 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 10/26/2005 has not been entered.

(5) Summary of Claimed Subject Matter

The examiner disagrees with the summary of claimed subject matter contained in the brief.

Particularly noted is the absent of any recitation regarding "(3) permitting the software application program to run *only* if a determination is made that a disabling instruction has been incorporated into the e-mail message that prevents the e-mail message with the appended software application program from being forwarded. " as recited in appellant's brief.

Appellant's only recitation regarding this feature may be found in his disclosure, on pages 3 and 7, where, it is described as a feature for preventing future or unauthorized additional installations. Forwarding or copying of a program for additional installation or execution, on subsequent computers or machines is prevented by the used mark that is recorded at the initial installation, see page 3, lines 10 et seq., and page 7, lines 9 et seq.. *Marking of the installation script as used also disables the forwarding mechanism of the electronic mail software to prevent the user from accessing or installing a second copy of the installation script or software, (page 3, lines 12 et seq.).* The specification only

appears to disable the running of the installation script and not the software application program. **The application software is enabled and disable via a value stored in the system's registry,** as evidenced by appellant's disclosure reciting, "When the application is launched/ [operated or run], the hard drive serial number is read from the installation machine... and compared to the value stored in the system registry. If the serial numbers match, the application is allowed to execute normally. If they do not match, the application terminates. This prevents the application from being used even if the entire hard drive image is copied to another machine, (see page 3, lines 17 et seq.)." Thus, it is the registered value not the marking of the do not forward instruction that prevents the application software from being executed or run.[emphasis added]. It is the installation script that the do not forward instruction (or determination) prevents running, not the application program. The running of the application program is tied to the valued stored in the register, which, is based upon the system's serial number not the do not forward instruction.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| 6,584,564 | OLKIN et al. | 6-2003 |
| 6,721,784 | LEONARD et al. | 3-2004 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: the final office action has been reproduced below. The remarks drawn to the advisory action are not subject to appeal, accordingly, they are deemed moot and will not be addressed by the examiner any further.

DETAILED ACTION

1.   Claims 1-45 have been cancelled by an amendment filed 5/2/05.

Claim Objections

2.   Applicant is advised that should claims (47 and 53), (60 and 54), (55 and 61), (56-57 and 62-63), be found allowable, said claims will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 46-57 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

As to claim 46-48, the claim recite, "Permitting the software application to

run...prevent the e-mail message ...from being forwarded..." As it is written it is unclear

as to who or who is permitting the software application from being run or forwarded.

There does not appear to be recitation as to who or who is making a determination or

similarly processing the additional steps in claims 47-48. Similar deficiencies are

believed to exist in claims 52-57.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   As understood in view of the 112 problems recited above, claims 46-75 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Olkin et al., U.S. Pat. No.

6,584,564 and Leonard et al., U.S. Pat. No. 6,721,784, hereinafter respectively '564 and

784.

7.   As per claims 46, '564 teach a method for secure electronic distribution of

software media files (fig. 3 and col. 5, lines 42 et seq.) over networks comprising: e-mail

as a delivery mechanism (abs., figs. 2b, 3, 5, 6a, col. 3, lines 30-45 et seq., appending

as an attachment/file/media/data/program (col. 14, lines 36 et seq.), e-mail message,

opening, installing (figs. 3, 5, 8, col. 4, lines 17-25 et seq.), marking (fig. 6c) and storing

said files on a receiving/recipients computer (fig. 6a-b, col. 4, lines 35 et seq.). It does

not teach marking the e-mail as used to prevent further installations/desired events that

is being forwarded.

8.   '784 teach saving and marking media files to prevent disable further

installations/events and being forwarded (figs. 4 and 5 respectively (220 and 330), fig.

12 (20), figs. 13 and 15, abs., figs. 3-8, col. 6, lines 20-35 et seq., col. 19, lines 25 et

seq., and col. 20-21). '784 also use special handling instructions as part of the

installation process, failure to follow these instruction results in either nullification of the

installation process or termination/failure (col. 18, lines 16-40 et seq.). It would have

been obvious to one of ordinary skill in the art at the time of the invention to modify the

software distribution of '564, with a means of enabling and controlling the distribution of

an electronically transmitted message, an e-mail attachment, as disclosed by '784. One

of ordinary skill in the art would have been motivated to perform such a modification,

because, one of ordinary skill in the art would have realized that the originator of a e-

mail message might desire to control the distribution and viewing of the content of said

e-mail data as a way of safe guarding the data against unauthorized use and/or

distribution (col. 3, lines 50 et seq., and col. 6, lines 20 et seq., and col. 19-21). A

person of ordinary skill in the art, desiring not to have a user exceed his authority to use

or distribute an email and its data would have desire to implement a means of ensuring

that the user and system afforded some means of preventing a specific

event/installation from occurring, i.e. forwarding. A skilled artisan with such a desire in mind would have viewed the invention of '784 as a means of adding access control and security features to the e-mail system, while still making the data readily available. The additional use and modification of the applets would have afforded the invention a greater degree of control and security.

9.   As per claims 47, '564 teach permitting an application to run if it is from a pre-specified e-mail server. '564 teach that a security server 24 and an e-mail server 22 work co-operatively, under the control of an applet program, with a sender to generate a unique key and ID/data for an encrypted e-mail message. This key is utilized along with a password to ensure registration and authentication of a receiving computer. The receiving computer cannot run the program if it does not register with the security server and thus the email server, thereby preventing execution if the key and ID data determination data is missing. '784 similarly, teach using applets to control the execution and delivery of e-mail messages and attachments (see col. 19, lines 47 et seq., thru col. 21).

10.   As per claim 48, the discontinuation of installation if unsaved is not explicitly taught. The examiner takes official notice of both the motive and modification necessary to have an applet discontinue installation if an application is not saved first/unsaved. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the invention of '564 and '784 to require that a computer determine whether an application has been saved, before allowing it to be installed. A person of ordinary skill in the art could have modified the java applet control program of

'564 and '784 to require that an e-mail attachment/program must be saved or else it is

preventing it from being installed. A person of ordinary skill in the art would have readily

envisaged that e-mail attachments may have become compromised, corrupted or been

exposed to a virus/worm. A person with such a desire in mind would have been

motivated to have the attachment/program saved before exposing their entire system to

its contents; moreover, if an attachment had become corrupted during the installation

process, then there would be no way of recovering the lost data without first

retransmission of the e-mail message. '564 provides for a myriad ways of installing e-

mail attachments see figs. 3, 5-8, col. 7, lines 55 thru, col. 8, lines 27 et seq.

11.   Alternatively, the e-mail attachments are routinely received and stored in the

inbox of a recipient's computer. System administrators conventionally require the

saving of executable objects to a safe space such as a protected zone or a computer

media before allowing installation on ones system. A person of ordinary skill in the art

would have readily envisaged that e-mail attachments may have become compromised,

corrupted or been exposed to a virus/worm. A person with such a desire in mind would

have been motivated to have the attachment/program saved before exposing their

entire system to its contents; moreover, if an attachment had become corrupted during

the installation process, then there would be no way of recovering the lost data without

first retransmission of the e-mail message. '564 provides for a myriad ways of installing

e-mail attachments see figs. 3,5-8, col. 7, lines 55 thru, col. 8, lines 27 et seq.

12.   As to claim 49, '564 allows imbedding instruction into the e-mail message,

encrypting a serial number/receiver data, decrypting, and comparing with a

registry/security server of authorized users/system. The security server and mail server

of '564 provides for a send secure feature. This feature requires that the receiving

computer first register for the secure servers in order to obtain secure e-mail and their

attachments. The applet then compares the information to verify the identity of the

recipient/receiving computer (figs. 7-8, col. 6, lines 12-col. 7, lines 25 et seq.).

13.   Alternatively, the encrypting of a serial number of the storage device in a registry,

'784 require that specific processes and events are followed as part of the installation

process, it does teach utilizing an encrypted form of the serial number as a part of

registering process for installation. It does, however, teach that the installation data

maybe stored either locally or remotely, see figs. 6, 9, and 16, and col. 16, lines 44 et

seq.. The examiner takes official notice of both the motive and modification necessary

for having a local processor store its identifying information/serial number/machine

identity in an encrypted registry as part of a validation/installation process. '564 is

being recited as support for the taking of official notice, see fig. 5, col. 8, lines 40-45 et

seq., and lines 60-67 et seq., col. 10, line 25 et seq. It would have been obvious to one

of ordinary skill in the art at the time of the invention, to modify the installation and

verification processes of '784 with an applet subroutine as taught by '564, for enabling

the installation and verification process to having a registry that has identifying

information that is machine or computer specific and dependent. One of ordinary skill in

the art would have been motivated to perform this modification, because, one would

have had a desire to ensure, that after supplying a secured e-mail or application, that

the data or program was not inappropriately stored or used on a machine for which it

was not intended. A person of ordinary skill would have chosen this or any other well proven method of protecting data as a means of providing additional steps in protecting their data or program, as suggest by "784 at abs., col. 1, lines 20-45, col. 3, lines 50 et seq., and col. 6, lines 20-34. '564 also indicates that the user may have various installable options associated with an applet to permit registration, see '564 at col. 4, lines 35 et seq., col. 6, lines, 13 et seq., and col. 8, lines 17-27 and 40-65 et seq.

14.   As to claims 50-51, the enabling of an authorized user identifier/password, and installing only once, co-operatively the single use key, read only once install each use, see '564 figs. 3, 6a-c, col. 7, lines 8 et seq., and col. 8, lines 15 et seq.

15.   As to claims 52-63 recite the concomitant elements of claims 46-51, accordingly they are rejected under the same rationale. See above for the specifics of the rejections.

16.   As per claims 64-69, they differ from rejected claims 46-64 by reciting a system for carrying out the process steps of the method claims. '564 provides a system having a means for appending, transmitting, receiving computer, permitting applications to run, a specified e-mail server (collectively 22 and 24), means for embedding, receiving encrypted, means for decryption, means for comparing, means for enabling/halting, hardware/system with accompanying functions as recited above (fig. 1, sender, receiver, e-mail server, security server, fig. 3, figs. 7-8 and col.5, lines 29 et seq.).

17.   As per claims 70-75, they differ from rejected claims 45-69, by reciting a machine-readable medium having a plurality of instructions embodied therein. '564

teaches embodying his invention in the form of software modules see fig.4, and col. 5,

lines 40 et seq., col. 6, lines 12 et seq., col. 7, lines 54 et seq., col. 8, lines 15 et seq.

Conclusion

18.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

19.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Norman Wright whose telephone number is (751) 272-

3844. The examiner can normally be reached on Mondays - Thursdays from 9am to

4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Greg Morse, can be reached on (571) 272-3838. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR

(10) Response to Argument

Appellant remarks that the 112 rejection of claims 46-52 is improper because

permitting the software application to run is clear and definite, the examiner does not

agree. As the claims are understood and written, it is unclear as to who or whom is

permitting the software application from being run or forwarded. There does not appear

to be recitation as to who or whom is making a determination or similarly processing the

additional steps in claims 47-48. Appellant in independent claim 46 recites, "permitting

the software application **to run only if a determination is made that a disabling**

instruction has been incorporated into the e-mail message that prevents the e-mail

message with the appended software application program from being forwarded." This

aspect of the claimed invention appears only to be mentioned on page 3 and 7 of the

appellant's disclosure. Appellant's disclosure recites, "...*After successful completion of*

the installation the script is marked used and cannot be used again [installation applet].

Marking of the installation script as used also disables the forwarding mechanism

of the electronic mail software to prevent the user from accessing a second copy

of the installation script or software, (page 3, lines 12 et seq.)." **Plainly put, the**

installation of the software prevents a second copy form being installed on a

computer system. It only disables the installation script not the application

software that is attached to the email. The 112-second rejection is deemed proper,

because, appellant has failed to clearly and distinctly identified what or which elements

is making a determination about which program. Appellant has disclosed an installation

script/ applet and an application software program. The specification only *appears to*

disable the running of the installation script and not the software application program.

The application software is enabled and disable via a value stored in the system's

registry, as evidenced by appellant's disclosure reciting, "When the application is

launched/ [operated or run], the hard drive serial number is read from the installation

machine...and compared to the value stored in the system registry. If the serial

numbers match, the application is allowed to execute normally. If they do not match,

the application terminates. This prevents the application from being used even if the

entire hard drive image is copied to another machine, (see page 3, lines 17 et seq.)."

Thus, it is the registered value not the marking of the do not forward instruction that

prevents the application software from being executed or run [emphasis added]. It is

the installation script that the do not forward instruction (or determination) prevents

running, not the application program. The running of the application program is tied to

the valued stored in the register, which is based upon the system's serial number; not

the do not forward instruction. Therefore, either applicant has misstated the claimed

invention, or at the very least it is unclear what or how the do not forward command is

tied to the executing of his application program, as it has been disclosed, in his

specification, to be <u>contrary to what he is suggesting as recited in his claims and appeal</u>

<u>brief.</u> The checking of the do not forward command before executing the software

application appears to be devoid of any suggestion or explicit teaching as disclosed in

the specification and drawings. Therefor, in view of the apparent contradiction, the

examiner presumed in this instance that appellant's invention had as a goal: 1) a

desired to have a do not forward options, and 2) a means of preventing the application

software from executing on subsequent machines as recited above. With such a goal in

mind the examiner applied two references that performed both of the understood

features of do not forward and prevention of copying, respectively, Olkin et al. '564 and

Leonard et al. '784. It appears that Appellant has recited steps or an apparatus for

performing disjoint process steps, particularly, his incorporation of a two step process of

determining if a do not forward has been incorporated into a script and a step for

preventing the execution of an application on a subsequent machine. Stated differently,

he has merged the two-step process into a single step, which has not been supported in

the disclosure. The difficulty determining the metes and bounds of the claims, results

from the fact that the claims appear to be indefinite and has not clearly and distinctly set

forth that which appellant has regarded as his invention.

Again on page 7, of appellant's disclosure similar recitation is found regarding the

features of do not forward as it applies to the installation script, and the prevention of

the execution of the software application on subsequent machines, see lines 19-23 et

seq. Here appellant recites that, "the final event [step two] is the enabling the application. The installation scripts stores the encrypted hard drive serial number in the system registry.... Serial number is read from the machine and compared to the value stored in the registry... if the serial numbers match, the application is allowed to start normally." Not withstanding, the reason recited above, equally apply to appellant's disclosure and the claimed invention with regards to page 7 of his specification.

Looking at Appellant's drawings figures 9 and 10, they plainly convey the interpretation put forth by the examiner. Figure 9, depicts the two-step process, at 108, it demonstrates the do not forward aspect of the script 102-112. Similarly, element 118 shows the encryption of the serial number hard drive, while 204-210 of figure 10 shows the comparison of the registered serial number. Appellant has recited that his claimed invention is something that is contrary to his specification, and since the drawings appear to be consistent with appellant's specification. The examiner has given the claims the broadest interpretation possible consistent with the specification, and that is, that the invention has a do not forward feature that prevents the installation script from being installed on subsequent machines, and a disabling feature for prevention the execution of the application software, i.e. based upon a registered value. The disclosure is silent and devoid of any teaching regarding the do not forward instruction preventing the execution of the software application. For the reasons recited above it is believed that the 112 rejection is proper.

As to the remarks regarding the 103 rejection, particularly claims 46-51, 64-69 and 70-75, appellant has opined that the prior art fails to teach the all of the claimed

limitations. Appellant remarks that, permitting the software application program to run only if a determination is made that a disabling instruction has been incorporated ... that prevents forwarding, has not been taught. The examiner does not concur.

First, as indicated above in the remarks to the 112, it is not believed that appellant invention has a single step process that checks for a disabling instruction, i.e. do not forward, and if and only if it is incorporated permits the execution of the software application. Olkin et al. '564 teach, similar to appellant, a secure method (col. 14, lines 18 et seq.) of transferring an e-mail, which may contain software applications, scripts or applets contained within the body of the email (col. 8, lines 8 et seq.). It provides for authentication of the receiver and following successful authentication either automatic or user installed options for the scripting the installation process. This process may be a plug in or a script or applet separate and apart from the attachment (col. 7, lines 54-61 et seq., col. 8, lines 8 et seq., and col. 13, lines 20 et seq.). . While '564 does provide for administration of maximum reads (col. 9, lines 32-35), and optional features of use permitted (col. 11, lines 19 et seq.), expiration time, number of recipients, or maximum number of deliveries (figs. 3 or 4, col. 13, lines 10 et seq.), and a reason for denial via a dialog box (col. 13, lines 40 et seq.). The "564 reference was absent any teaching of checking the e-mail for a forwarding instructions.

Leonard et al. '784 teaches an e-mail system and method for having an event, date, or time to control and track the handling of emails the messages by recipients via a viewer applet (see abs., figs. 2-7, [2, 11-12, 260, 340], figs. 12-13, control applet [12], col. 14, lines 40-56 et seq., col. 15, lines 1-10, 29-45, and col. 16, lines 12-20 and 44-

56). In column 6, lines 19-34 et seq., '784 teach the use of viewer applets for

distributing e-mails and controlling them after installation of the viewer applets. He also

goes further to state that his system provides for originator control over the lifespan of

the message (col. 5, lines 26 et seq.), and that his invention extends the concept of

supplying executable programs files communicated via e-mails (col. 6, lines 43 et seq.).

One of the control features provided by '784 is the do not forward options (see fig. 5,

[340], and fig. 12 [20]). A detailed description is given in col. 19-20, of particular note is

the use of lifespan control printing, permitting or prohibiting of alterations and *forwarding*

(col. 19, line 55-67, col. 20 lines 1-14, and 50-65, col. 21, lines 1-10, and col. 22, lines

28-45 et seq.). Appellant asserts that there is no reason to combine the prior art, the

examiner does not concur. '564 teach an email system for securing emails and their

attachments (programs) following installation of a script, applet or program. '564

provides a flexible and convenient way of registering and controlling or running software

modules following authentication and installation of plug-in, script, or applets (col. 18,

lines 44 et seq.). Furthermore, the invention is easily incorporated into existing systems

utilized on the internet (col. 19, lines 26 et seq.). Leonard '784 teaches a way of

controlling e-mail attachment via lifespan controls, notably the do not forward feature

(fig. 5 and 14). '784 is also not limited to any particular e-mail system and maybe

implemented in existing systems (col. 7, lines 5-20). Similarly, his system is also

implemented following a success installation of a viewer program, script, or applet

(col.19, lines 55 et seq., and col. 22, lines 28 et seq.). Therefore, it is believed that

since both inventions are from the same field of endeavour, and are both are generally

concerned with the security of e-mails and their attachments. Namely, the restriction

and control on the use of e-mail attachments following an installation process.

Furthermore, since both '784 and 564 are not restricted to any particular e-mail system

and are both designed to be readily implemented into any existing system. It is

believed, as recited in the office action that, a person of ordinary skill in the art would

have look to the invention of '784 as an added means of protecting the security and

control of an attachment from unauthorized access or transferral. Both have suggested

that other control options are available and could readily be implemented.

As to the remarks regarding the pre-specified e-mail server being taught, both

teach this feature. '564 utilizes an encryption scheme for ensuring that only a specified

user receives and utilizes the e-mail by requiring the use to have a key or pre-register

(see col. 4, lines 1-44, and col. 6, lines 29 et seq., and figs. 1 and 4). '784 teach the

features at figures1-3, and 16, and col. 13, lines 5-14 et seq.. The claimed limitation

regarding a specified server only requires a server provides the e-mail to a receiving

computer; both clearly perform that function as claimed.

As to the remark that neither reference teach if the e-mail is not saved by the

computer discontinuing the installation process. If the e-mails were not saved then the

recipient would not receive it. Stated differently, the whole process of receiving e-mail

for verification and subsequently installation is built on the fact that the email is has

been received (i.e. buffered, stored, or at least in your inbox). The examiner was trying

to clarify by saying that the prevention of installation based upon a determination that

email is not stored is not taught. Here in both examples of the prior art '784 and '564,

their inventions would not even begin to work if the email was not received by the
recipient and stored or buffered on their computer system/network. Recall, that it is the
encrypted e-mail that is check and verified before the installation process even begins.
It is inherent that it has been saved or else the viewer, script, or installation applet would
not have been decrypted, from the body of the email, and utilized to decrypt the
contents for which the viewer is provided. Not withstanding, this is not a patentable
distinction, just a difference is wording. The examiner is perplexed by the remarks, that
an email determination must be made with regards to storage, or else it will discontinue
installation of the program that is contained within the email. Keep in mind that it is the
email that contains the program for execution that is going to be installed. Moreover, all
executable instruction or program requires storage or buffering before executable
program may be executed via a processor. Here there is a clear showing that the
viewer applet or script is the program code that must be installed prior to the installation
of the application program also contained within the program. Therefore, if one did not
save the email, then one would not have access to the applet or script to install and
decode the application program contained within the email. Program must inherently be
buffered or stored prior to execution, and emails must be received and stored prior to
their use, especially if they contain an executable program. It is believed that no
additional reference is required, as it is illogical for the recited functions to occur in the
context of the claimed invention. That is it is not understood how an unsaved e-mail
could execute the installation of a program it contains if it is not stored. Not
withstanding '784 teaches special handling instruction as part of the installation process

see col. 18, lines 16-40, if a failure occurs during the installation of the viewer the whole

process is deleted, or the email message is deleted. Therefore, an unsuccessfully

saved email would logically result in termination of the installation program that is

contained within the email, because the code necessary for installation would not be

able to be retrieved by the executing processor.

As to the remarks regarding the use of comparing the serial number of a

computer for gaining access to a program, the examiner again disagrees with appellant.

First, official notice was taken of this feature in an office action dated 1/31/2005, see

below: The examiner takes official notice of both the motive and modification necessary

for having a local processor store its identifying information/serial number/machine

identity in an encrypted registry as part of a validation/installation process.   '564 is

being recited as support for the taking of official notice, see fig. 5, col. 8, lines 40-45 et

seq., and lines 60-67 et seq., col. 10, line 25 et seq. It would have been obvious to one

of ordinary skill in the art at the time of the invention, to modify the installation and

verification processes of '784 with an applet subroutine as taught by '564, for enabling

the installation and verification process to having a registry that has identifying

information that is machine or computer specific and dependent. One of ordinary skill in

the art would have been motivated to perform this modification, because, one would

have had a desire to ensure, that after supplying a secured e-mail or application, that

the data or program was not inappropriately stored or used on a machine for which it

was not intended. A person of ordinary skill would have chosen this or any other well

proven method of protecting data as a means of providing additional steps in protecting

their data or program, as suggest by "784 at abs., col. 1, lines 20-45, col. 3, lines 50 et seq., and col. 6, lines 20-34. '564 also indicates that the user may have various installable options associated with an applet to permit registration, see '564 at col. 4, lines 35 et seq., col. 6, lines, 13 et seq., and col. 8, lines 17-27 and 40-65 et seq.

This taking of official notice was not seasonably challenged in the next official correspondence to the office, and the claimed limitation were cancelled from claims 1-45 and reinstated in the pending claims (i.e. claim 61). This lack of challenged is viewed to be an admission of appellant and now he wishes to reassert that it is not well known in the art. If it was notoriously well known in the previous office action is still well known in this office action, accordingly any further proof of its veracity is not deemed necessary.

As to the remarks that the installation can occur only once and the prior art has not taught this feature, the examiner does not agree.

Specifically, '564 teaches an enabling mechanism for single use key and any arbitrary number of installation, specifically, "the maximum number of times that each receiver open and read a secure e-mail [thus install or use]" see col. 9, lines 33 et seq. "A default may be zero, meaning that there is no limit," col. 9, lines 36 et seq., see also figs 3, 6a-6c. Similarly, 784 teach a read once option, see figs. 4 (280) and 5 (260), which has been grossly incorporated into the rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Norman Wright

NORMAN M. WRIGHT
PRIMARY EXAMINER

Conferees:

Gilberto Barron
SPE 2132

Matthew Smithers